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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,430	01/10/2002	Tadayuki Fujiwara	218059US0PCT	6572

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1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

ASHTON, ROSEMARY E

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/030,430

Applicant(s)

FUJIWARA ET AL.

Examiner

Rosemary E. Ashton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,10 and 11 is/are rejected.
- 7) ☒ Claim(s) 4 and 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

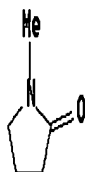
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,2,3,5,6,10,11 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al U.S. patent no. 5,876,900 cited on applicant's IDS.

Example 2 in Table 1 shows a photoresist composition comprising a styrenic polymer having hydroxyl groups replaced with acid labile tBOC groups so that the polymer is acid sensitive, a photoacid generator (PAG) and a basic compound of N-methylpyrrolidone shown below. As to claims 5,6,10,11 Watanabe does not teach the pKa of the conjugate acid of N-methylpyrrolidone or its LOG P, however, it is the examiner's position, absent evidence to the contrary, that N-methylpyrrolidone inherently meets the limitations of these properties because N-alkyl pyrrolidone is one of the compounds taught in the specification to meet the claimed properties. Other nitrogenous compounds taught in Watanabe also are disclosed in the instant application such as N,N-dimethylformamide and N-methylacetamide (col. 24, lines 24-28) which may be used with Polymer 3 or 4 as shown in Table 1.



3. Claims 1,2,3,5,6,10,11 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al U.S. patent no. 5,770,343 equivalent to EP 749044 cited on applicant's IDS.

Example 2 in col. 6 shows a photoresist composition comprising a styrenic polymer having hydroxyl groups replaced with acid labile tBOC groups so that the polymer is acid sensitive, a photoacid generator (PAG) and a basic compound of N,N-dimethylacetamide. As to claims 5,6,10,11 Sati does not teach the pKa of the conjugate acid of N,N-dimethylacetamide or its LOG P, however, it is the examiner's position, absent evidence to the contrary, that N,N-dimethylacetamide inherently meets the limitations of these properties because N alkyl acetamide is one of the compounds taught in the specification to meet the claimed properties.

***Allowable Subject Matter***

4. Claims 4,7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach the amide formula having a cyclic structure for R1 or R2 or the polymer in claims 7-9.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosemary E. Ashton whose telephone number is 703-308-2057. The examiner works a flexible work schedule and can normally be reached M-F between 10:00 am – 5:00 pm.

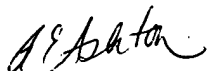
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached at 703-308-2303.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communication.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Rosemary E. Ashton  
Primary Examiner  
Art Unit 1752

rea  
August 11, 2003

**ROSEMARY ASHTON**  
**PRIMARY EXAMINER**